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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/664,969	09/16/2000	Robert Antonacci	865-002u	4464
7590 07/17/2008 SOFER & HAROUN L.L.P. 317 MADISON AVENUE SUITE 910 NEW YORK, NY 10017				
			EXAMINER PARK, CHAN S	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 07/17/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/664,969

Applicant(s)

ANTONACCI ET AL.

Examiner

CHAN S. PARK

Art Unit

2625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-42, 44, 47, 49, 50 and 53-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41, 42, 44, 47, 49, 50, 56 and 57 is/are rejected.
- 7) ☒ Claim(s) 37-40 and 53-55 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/3508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/07 has been entered.

Response to Amendment

2. Applicant's amendment was received on 10/31/07, and has been entered and made of record. Currently, **claims 37-42, 44, 47, 49, 50 and 53-57** are pending.

Drawings

3. The corrected or substitute drawings were received on 10/31/07. The drawings are acceptable.

Response to Arguments

4. Applicant's arguments with respect to **claims 37-42, 44, 47, 49, 50 and 53-57** have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

5. Claims are objected to because of the following informalities:

Claim 37, line 4, "said medical facility" should be -- a health care provider --;

Claim 37, line 7, "said coded health" should be -- said second coded health --;

and

Claim 40, line 3, "blood test, radiology, EKG" should be -- blood test, radiology
and EKG --.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 41, 42, 44, 47, 49, 50, 56 and 57 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. MPEP 706.03(a) states "a mere arrangement of printed matter, though seemingly a "manufacture," is rejected as not being within the statutory classes". The claimed "transmission paper" is nothing more than "a mere arrangement of printed matter". Furthermore, this paper is construed as a non-functional material since the paper only comprises a bunch of printed matters which must be read by a device in order to perform any functions.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 49 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 49 recites the limitation "said apparatus". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 41, 42, 44, 47, 49, 50, 56 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rozen et al. U.S. Patent No. 6,073,106 (hereinafter Rozen) in view of Melen U.S. Patent No. 6,426,806.

With respect to claim 41, Rozen discloses a transmission paper for medical records said transmission paper comprising:

a patient's account (col. 9, lines 8-22), configured to be (the examiner notes that the clause "configured to be" is nothing more than an intended use statement. Hence, the claim limitation after the clause is given no patentable weight. See MPEP 2106

section II & 2111.04) separately transmitted along with a patient's medical records via a public switched telephone network to a processor, said processor configured to store said patient's medical record in a location relating to said patient's account such that a plurality of health care providers employ a copy of the same transmission paper to transmit various medical records corresponding to said patient said transmission paper further maintaining a coded health care provider identifier (col. 7, lines 57-60 & col. 6, lines 20-24), said coded health care provider identifier identifying said health care provider, among a plurality of health care providers, submitting said patient's medical record (again, the rest of claim is an intended use statement except said coded health care provider identifier).

Rozen, however, does not explicitly disclose that a barcode associated with a patient's account is included in the transmission paper.

Melen, the same field of endeavor of storing the scanned data in a database for later retrieval, discloses a cover sheet having a barcode for identifying account associated with the documents and designating a storage location where the document should be stored (col. 2, line 17 - col. 3, line 26).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the barcode in the transmission paper of Rozen.

The suggestion/motivation for doing so would have been to increase the accuracy in identifying the patient's account by applying the barcode in the facsimile cover sheet.

Therefore, it would have been obvious to combine Rozen with Melen to obtain the invention as specified in claim 41.

Claim 41 appears to claim a paper with a barcode associated with a patient's account.

With respect to claim 42, Rozen discloses the transmission paper comprising payment information of said patient (col. 6, line 23).

With respect to claim 44, Rozen discloses the transmission paper further comprising a patient access code associated with said barcode (col. 5, lines 49-67 of Rozen & col. 2, line 17 - col. 3, line 26 of Melen).

With respect to claim 47, Rozen discloses the transmission paper wherein said patient access code information further comprises a password (col. 5, lines 49-67).

With respect to claims 49 and 50, refer to col. 7, lines 1-3 & 40-67 of Rozen.

With respect to claims 56-57, the claims are again the intended use statement.

Allowable Subject Matter

9. Claims 37-40 and 53-55 would be allowable if rewritten or amended to overcome the claim objections, set forth in this Office action.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571)272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHAN S PARK/
Examiner, Art Unit 2625

June 4, 2008